

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.	:	09/829721	Appeal No. 2008-3091
Applicant	:	Glenn R. Smith, et al.	Confirmation No. 8452
Filed	:	April 10, 2001	
TC/A.U.	:	2178	
Examiner	:	Gregory J. Vaughn	
Title	:	TEXT ENTRY DIALOG BOX SYSTEM AND METHOD OF USING SAME	
Docket No.	:	SVL920010005US1	
Customer No.	:	46158	

REPLY BRIEF
(37 C.F.R. § 41.41)

Sir:

This Reply Brief is filed in response to the Supplemental Examiner's Answer mailed on March 10, 2008.

I. REAL PARTY IN INTEREST

Both the Examiner and Appellants agree that the real party in interest for this appeal and the present application is International Business Machines Corporation, by way of an Assignment recorded in the U.S. Patent and Trademark Office at Reel 011720, Frame 0530.

II. RELATED APPEALS AND INTERFERENCES

The Examiner is unaware of any related appeals, interferences, or judicial proceedings, and Appellants have stated in the record that there are no such appeal, interferences or judicial proceedings known to Appellants that may be related to, or which

will directly affect or be directly affected by or have a bearing upon the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Both the Examiner and Appellants agree that the status of claims contained in the appeal Brief is correct.

IV. STATUS OF AMENDMENTS AFTER FINAL

Both the Examiner and Appellants agree that the statement of the status of amendments after final rejection contained in the Appeal Brief is correct.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Both the Examiner and Appellants agree that the summary of claimed subject matter as set out in the Appeal Brief is correct.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Both the Examiner and Appellants agree that the statement of grounds of rejection to be reviewed on appeal as set out in the Appeal Brief is correct.

VII. CLAIMS APPENDIX

Both the Examiner and Appellants agree that the copy of the appealed claims contained in the Appendix portion of the Appeal is correct.

VIII. EVIDENCE APPENDIX

Both the Examiner and Appellants agree that the evidence relied upon by the Examiner in the instant appeal is as follows:

1. Microsoft Word, copyright 1993-1999 by Microsoft Corporation (hereinafter MS Word) note: screenshots of the software application running on the Examiner's computer workstation are used as prior art.
2. William B. Hayes using PowerBuilder 6, published by QUE Corporation in 1997, (hereinafter PowerBuilder 6).

IX. GROUNDS OF REJECTION

Both the Examiner and Appellants agree that claims 2, 3, 6-8, 11-13, 15, 16, 21 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over MS Word, in view of PowerBuilder 6.

X. RESPONSE TO ARGUMENT

- A. The Examiner's response to Appellants' argument that there is a lack of motivation to combine MS Word and PowerBuilder 6:

The Supplemental Examiner's Answer mailed on March 10, 2008 essentially repeated, verbatim, the remarks made in the Examiner's Answer mailed on January 10, 2007.

So as to not burden the record, Appellants' remarks and arguments contained in the Reply Brief of March 19, 2007 are incorporated herein, and repeated, by reference.

- B. The Examiner's response to Appellants' argument that the motivation to combine MS Word and PowerBuilder 6 is taken from the present application:

The Supplemental Examiner's Answer mailed on March 10, 2008 essentially repeated, verbatim, the remarks made in the Examiner's Answer mailed on January 10, 2007.

So as to not burden the record, Appellants' remarks and arguments contained in the Reply Brief of March 19, 2007 are incorporated herein, and repeated, by reference.

- C. The Examiner's response to Appellants' argument that MS Word teaches away from the combination with PowerBuilder 6:

The Supplemental Examiner's Answer mailed on March 10, 2008 essentially repeated, verbatim, the remarks made in the Examiner's Answer mailed on January 10, 2007.

So as to not burden the record, Appellants' remarks and arguments contained in the Reply Brief of March 19, 2007 are incorporated herein, and repeated, by reference.

D. Examination Guidelines:

Yet another reason as to why the present rejections are deficient and must be withdrawn and all claims allowed, relates to the recently issued "Examination Guidelines for Determining Obviousness Under 35 USC 103 In View of the Supreme Court Decision in *KSR International Co. v. Teleflex*," published in the Federal Register, Vol. 72, No. 195, Oct. 10, 2007.¹ As explained in those guidelines, the Supreme Court stated that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." Fed Reg. 57528-57529, citing *KSR*, 550 US at ___, 82 USPQ2d at 1396.

In the final Office action of March 20, 2006, the Examiner took the position that "it would have been obvious, to one of ordinary skill in the art, at the time the invention was made to modify the MS Word Find and Replace text entry dialog box with the selectively displayed controls as taught in PowerBuilder 6 in order to provide a visible indication that the control is usable." The Examiner then proceeded to assemble the claimed invention from selected portions of the prior art teachings.

The Examination Guidelines were not available to the Examiner in March of 2006 to use and/or apply in the Office action, but they were available for use in the Supplemental Examiner's Answer of March 10, 2008. However, it does not appear that the Examiner chose to use these prescribed Guidelines in reiterating and/or in clarifying the positions taken by the Office such as might be expected in a Supplemental paper.

¹ The Guidelines state that they are effective October 10, 2007.

Instead, again, the Examiner's Answer of March 10, 2008 was, essentially, repeated verbatim.

In general, the Examination Guidelines describe specific findings that the Examiner must make in order to properly reject claims under various rationales. One of the accepted rationales, and one which the Examiner apparently relies upon, is "Use of Known Technique to Improve Similar Devices in the Same Way." Another of the accepted rationales, and one which the Examiner may be relying upon, is "Applying a Known Technique to a Known Device Ready for Improvement to Yield Predictable Results."

Under the first rationale of "Use of Known Technique to Improve Similar Devices in the Same Way":

To reject a claim based on this rationale, Office personnel must resolve the *Graham* factual inquiries. Office personnel must then articulate the following:

- (1) a finding that the prior art contained a "base" device upon which the claimed invention can be seen as an "improvement;"
- (2) a finding that the prior art contained a "comparable" device that was improved in the same way as the claimed invention;
- (3) a finding that one of ordinary skill in the art could have applied the known "improvement" technique in the same way to the "base" device and the results would have been predictable to one of ordinary skill in the art; and
- (4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

The Guidelines continue and state that:

If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.

Federal Register at 57532.

Regarding the first factor, the Examiner conceded that in MS Word, "the show-list-button is always displayed" and that "MS Word fails to disclose the selective display

of a selection button (i.e. the show-list-button) associated with the dialog box, where the selection button is visible when at least one text entry is stored in memory." Therefore, the claimed device (method or product) can be seen as an improvement over the MS Word teachings because, in the claimed device (method or product) the show-list-button is NOT always displayed.

In independent claim 1, for example, the selection button is displayed solely when the memory contains at least one previously entered text item. In independent claim 8, for example, the drop-down list selection button is displayed only if a counting (of text entries) produces a value greater than zero. In independent claim 21, the drop-down list selection button is displayed in conjunction with the free-form text entry portion only when the memory contains at least one previously entered free-form text entry.

As for the second factor, the Examiner cited PowerBuilder 6. However, the Examiner did not demonstrate that PowerBuilder 6 is a device (method or product) comparable to either the claimed invention or to MS Word. Further, the Examiner did not show that PowerBuilder 6 was improved in the same way as the claimed invention, i.e., that the show-list-button is NOT always displayed in a free-form text entry box.

The Examiner did not show that a selection button is displayed solely when a memory contains at least one previously entered text item. He did not show that a drop-down list selection button is displayed only if a counting produces a value greater than zero. Lastly, the Examiner did not show in PowerBuilder 6 that a drop-down list selection button is displayed in conjunction with a free-form text entry portion only when a memory contains at least one previously entered free-form text entry.

Concerning the third factor, the Examiner did not demonstrate that one of ordinary skill in the art could have applied the "known improvement" technique in the same way to the "base" device of MS Word because, essentially, PowerBuilder 6 does not teach the "improvement" purportedly shown as argued by the Examiner.

Concerning the fourth factor, the Examiner alleges in a conclusory statement that, "it would have been obvious, to one of ordinary skill in the art, at the time the invention was made to modify the MS Word Find and Replace text entry dialog box with the selectively displayed controls as taught in PowerBuilder 6 in order to provide a visible indication that the control is usable." This is a mere unsupported conclusion. This is not a finding that "the prior art contained a "comparable" device that was improved in the same way as the claimed invention." This is not such a finding because the Examiner is attempting to select portions of the prior art and construct the claimed invention based on the blueprint set out therefore in the claims.

Under the second rationale of "Applying a Known Technique to a Known Device Ready for Improvement to Yield Predictable Results":

To reject a claim based on this rationale, Office personnel must resolve the *Graham* factual inquiries. Office personnel must then articulate the following:

- (1) a finding that the prior art contained a "base" device upon which the claimed invention can be seen as an "improvement;"
- (2) a finding that the prior art contained a known technique that is applicable to the base device;
- (3) a finding that one of ordinary skill in the art would have recognized that applying the known technique would have yielded predictable results and resulted in an improved system; and
- (4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

The Guidelines continue and state that:

If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.

Federal Register at 57532.

Regarding the first factor, the Examiner conceded that in MS Word, "the show-list-button is always displayed" and that "MS Word fails to disclose the selective display of a selection button (i.e. the show-list-button) associated with the dialog box, where the selection button is visible when at least one text entry is stored in memory." Therefore, apparently, the claimed device (method or product) can be seen as an improvement over the MS Word teachings because, in the claimed device (method or product) the show-list-button is NOT always displayed.

In independent claim 1, for example, the selection button is displayed solely when the memory contains at least one previously entered text item. In independent claim 8, for example, the drop-down list selection button is displayed only if a counting (of text entries) produces a value greater than zero. In independent claim 21, the drop-down list selection button is displayed in conjunction with the free-form text entry portion only when the memory contains at least one previously entered free-form text entry.

As for the second factor, the Examiner cited PowerBuilder 6. However, the Examiner did not demonstrate that PowerBuilder 6 is a device (method or product) that includes a technique of a selection button being displayed solely when a memory contains at least one previously entered text item.

Concerning the third factor, the Examiner was unable to show that one of ordinary skill in the art would have recognized that applying the "known technique" would have yielded predictable results because again, the technique of NOT displaying

the selection button under the circumstances as set forth in the pending claims was, heretofore, not a "known technique."

Concerning the fourth factor, the Examiner alleges in a conclusory statement that, "it would have been obvious, to one of ordinary skill in the art, at the time the invention was made to modify the MS Word Find and Replace text entry dialog box with the selectively displayed controls as taught in PowerBuilder 6 in order to provide a visible indication that the control is usable." This is a mere unsupported conclusion. This is not a finding that "the prior art contained a "base" device "or a "known technique" or that application of this technique to the base device would yield predictable results." This is not such a finding because the Examiner is attempting to select portions of the prior art and construct the claimed invention based on the blueprint set out therefore in the claims.

In summary, the Examiner's approach to the present rejection is merely an attempt to recreate the claimed subject matter by hindsight reconstruction. Recreating the claimed subject matter by piecing together the prior art is not the standard by which obviousness is measured. "Care must be taken to avoid hindsight reconstruction by using 'the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.' " *Grain Processing Corp. v. American Maize-Products Corp.*, 840 F.2d 902, 5 USPQ2d 1788 (Fed Cir. 1988); "Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention." *ATD Corp. v. Lydall, Inc.*, 159 F3d 534, 48 USPQ2d 1321 (Fed Cir 1998).

In addition, it is respectfully submitted that the present rejection is not in accordance with the Examination Guidelines issued by the Office and the Examiner has not clarified the previous rejections with these new Guidelines in the Supplemental Examiner's Answer of March 10, 2008. In order to reject the claims under either the "Use of Known Technique to Improve Similar Devices in the Same Way" accepted rationale or the "Applying a Known Technique to a Known Device Ready for Improvement to Yield Predictable Results" accepted rationale, the Examiner was required to make various specific findings. Those findings were not made. Therefore, as the Guidelines state, "[i]f any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art."

E. "Always Show Arrow":

As to the "Always Show Arrow" the Examiner cites PowerBuilder 6 for "conditional program execution related to visibility of the arrow." However, the showing or non-showing of the arrow is only relevant to the user when the box has focus and, as conceded by the Examiner, in PowerBuilder 6, "the arrow is shown only when the column has focus."

F. Disable Scroll:

As to the "Disable Scroll" the Examiner cites PowerBuilder 6 for "selectively displaying a text entry box control, wherein the selective displaying is based upon the items stored in memory." However, as more accurately described in PowerBuilder 6 on page 2, "the scroll bar will be displayed only if necessary, based on the number of items and the

height of the listbox." This means, properly interpreted, that the scroll bar will be displayed when the listbox is too small to accommodate all of the items to be displayed in it.

CONCLUSION

In view of the foregoing remarks, Appellants respectfully request that the application be reconsidered and all pending claims be allowed.

For all of the reasons discussed above, it is respectfully submitted that the rejections are in error and that claims 2, 3, 6-8, 11-13, 15, 16, 21, and 22 are in condition for allowance.

For all of the above reasons, Appellants respectfully request this Honorable Board to reverse the rejections of claims 2, 3, 6-8, 11-13, 15, 16, 21, and 22.

Respectfully submitted,

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